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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,257	02/13/2006	Jung-Keun Kim	1222003USA	9671
7590		01/09/2008	EXAMINER	
JHK Law		ISSAC, ROY P		
P.O. Box 1078		ART UNIT		
La Canada, CA 91012-1078		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/568,257

Applicant(s)

KIM ET AL.

Examiner

Roy P. Issac

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1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-12 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/13/07 has been entered.

This Office Action is in response to Applicant's amendment/ remarks/ response filed 10/16/07 wherein claims 7 and 9 have been amended. Claims 6-12 are currently pending from which claims 6 and 12 are withdrawn from consideration. Claims 7-11 are examined on the merits herein. In the Remarks submitted by applicants dated 10/16/07, page 6, a declaration by co-inventor Jung-Keun Kim is mentioned. However, no declaration was received with filing on 10/16/07.

### ***Election/Restrictions***

Once the product claims are found allowable, pursuant to the procedures set forth in MPEP § 821.04(B), claims 6 and 12, directed to the process of making or using an allowable product, previously withdrawn from consideration as a result of a restriction requirement will be rejoined and fully examined for patentability under 37 CFR 1.104.

### **Rejections Withdrawn**

Applicants' amendment to claim 7 wherein the recitation "extract of" overcomes rejection of claims 7-11 under section 112, second paragraph.

Applicants' amendment replacing the transitional phrase "comprising" with "consisting of" in claims 7 and 9 overcome the rejection under section 102(b) of claims 7-11 over Cui et. al.

### ***Claim Objections***

Claims 8, 10 and 11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 9 recites the closed transitional phrase "consisting of" which does not permit the inclusion of additional ingredients in the composition. Dependent claim that depends from claim 9 lists additional such as processed meats, flour food, ketchup etc.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et. al. (CN 14188690A; Derwent Abstract; Of record).

Lin et. al. discloses an extract of the root of Notoginseng. The extraction is prepared by ethyl alcohol or n-butanol and used for tablets and capsules. The recitations, "for treating arthritis", and "health food composition" are considered intended use of the extract. Note that it is well settled that "intended use" of a composition or product, e.g., "treating arthritis", will not further limit claims drawn to a composition or product, so long as the prior art discloses the same composition comprising the same ingredients in an effective amount, as the instantly claimed. See, e.g., *Ex parte Masham*, 2 USPQ2d 1647 (1987) and *In re Hack* 114, USPQ 161. The extraction is made by ethanol and butanol. Since both solvents used are similar alcohols, they are expected to produce the same composition as the butanol fraction as claimed herein. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et. al. (Abstract; CN 1267665, 2000; PTO-892).

Chen et. al. discloses butanol water extracts of notoginseng. It appears to be the same as the butanol fraction of ethanol extract claimed herein. Since the Office does

not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980).

Claims 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu et. al. (U.S. Patent No. 4,755,504; Of Record).

Liu et. al. discloses a pharmaceutical compositions containing saponin and quercetin derived from Tienchi for the treatment of circulatory disease and as health food. The ingredients are derived from the root Tienchi. Tienchi is the Chinese name for *Panax Notoginseng*. (Column 1, lines 12-19). A method for extracting Tienchi roots (radix) using ethanol followed by butanol extraction is disclosed. (Example 2, Column 4). . As noted above, the recitations, "for treating arthritis", and "health food composition" are considered intended use of the extract. Since the extraction was performed by 95% ethanol, which indicates the presence of water the product claimed herein and that disclosed by Liu appears to be the same. Since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). As such, claims 7-11 are anticipated by Liu et. al.

***Response to Arguments***

Applicant's arguments filed 10/16/07 have been fully considered but they are not persuasive. Applicants argue that anti-inflammation effects and arthritis treatment are distinct from each other. However, the claims herein are directed to compositions. As noted in the previous office action, the intended use of a product will not further limit the product claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy P. Issac whose telephone number is 571-272-2674. The examiner can normally be reached on 9:00-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Anna Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Roy P. Issac  
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 4/7/08  
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